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EXAMINER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* HIROSHI KAMIYA
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11 Appeal 2009-010971
12 Application 09/782,017
13 Technology Center 3600
14

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16 Decided: June 18, 2010
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19 Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W.
20 FETTING, *Administrative Patent Judges*.

21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL
23

STATEMENT OF THE CASE

Hiroshi Kamiya (Appellant) seeks review under 35 U.S.C. § 134 (2002) of a final rejection of claims 1-47, the only claims pending in the application on appeal.

We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION¹

We AFFIRM.

THE INVENTION

The Appellant invented a commodity ordering issuing and accepting method, a system thereof, and a commodity order accepting apparatus to those using the Internet (Specification 1:6-8).

An understanding of the invention can be derived from a reading of exemplary claims 1, 2, and 43, which are reproduced below [bracketed matter and some paragraphing added].

1. A commodity order issuing and accepting method, comprising:

[1] providing an order issuing device capable of electronic communications;

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed September 15, 2008) and Reply Brief (“Reply Br.,” filed February 10, 2009), and the Examiner’s Answer (“Ans.,” mailed December 10, 2008), and Final Rejection (“Final Rej.,” mailed January 8, 2008).

1 [2] providing an order accepting device capable of electronic
2 communications;

3 [3] requesting a first electronic document comprising first
4 input fields for accepting order issuer information and for
5 accepting commodity order issuance information except for an
6 order issuer's payment date from said order accepting device;

7 [4] transmitting said first electronic document to said order
8 issuing device;

9 [5] inputting said order issuer information and said
10 commodity order issuance information except for said order
11 issuer's payment date into said first input fields on said order
12 issuing device;

13 [6] transmitting said order issuer information and said
14 commodity order issuance information except for said order
15 issuer's payment date to said order accepting device;

16 [7] retrieving a transaction condition corresponding to said
17 commodity order issuance information on said order accepting
18 device;

19 [8] transmitting a second electronic document on which said
20 transaction condition is described and which has a second input
21 field for said order issuer's payment date to said order issuing
22 device;

23 [9] inputting said order issuer's payment date into said
24 second input field on said order issuing device; and

25 [10] transmitting said order issuer's payment date to said order
26 accepting device, wherein said second electronic document
27 comprises a formula for calculating a payment price based on
28 said order issuer's payment date.

29

30 2. The commodity order issuing and accepting method as set
31 forth in claim 1, further comprising:

32 calculating a reduced price corresponding to said transaction
33 condition and said order issuer's payment date on said order
34 accepting device.

35

43. The commodity order issuing and accepting method of claim 1, wherein the second electronic document comprises fields displaying a regular payment amount and a payment due date, the regular payment amount being due on the payment due date, and wherein the payment amount and the payment due date are determined by the order accepting device.

8 THE REJECTIONS

9 The Examiner relies upon the following prior art:

Benton et al.	US 4,926,325	May 15, 1990
O'Hagan et al.	US 6,314,406 B1	Nov. 6, 2001
Walker et al.	US 6,405,174 B1	Jun. 11, 2002
Murcko, Jr.	US 6,578,014 B1	Jun. 10, 2003

10 Claims 1, 4, 7, 10, and 13-42 stand rejected under 35 U.S.C. § 103(a) as
11 being unpatentable over Murcko and Benton.

12 Claims 2-3, 5-6, 8-9, and 11-12 stand rejected under 35 U.S.C. § 103(a)
13 as being unpatentable over Murcko, Benton, and O'Hagan.

14 Claims 43-47 stand rejected under 35 U.S.C. § 103(a) as being
15 unpatentable over Murcko, Benton, and Walker.

17 ISSUES

18 The issue of whether the Examiner erred in rejecting claims 1, 4, 7, 10,
19 and 13-42 under 35 U.S.C. § 103(a) as unpatentable over Murcko and
20 Benton turns on whether Murcko describes a second electronic document

1 that comprises a formula for calculating a payment price based on said order
2 issuer's payment date.

3 The issue of whether the Examiner erred in rejecting claims 2-3, 5-6, 8-
4 9, and 11-12 under 35 U.S.C. § 103(a) as unpatentable over Murcko,
5 Benton, and O'Hagan turns on whether O'Hagan describes calculating a
6 reduced price, as required by claims 2 and 5.

7 The issue of whether the Examiner erred in rejecting claims 43-47 under
8 35 U.S.C. § 103(a) as unpatentable over Murcko, Benton, and Walker turns
9 on whether the Appellant's arguments in support of the independent claims
10 is found persuasive.

11
12 **FACTS PERTINENT TO THE ISSUES**

13 The following enumerated Findings of Fact (FF) are believed to be
14 supported by a preponderance of the evidence.

15 *Facts Related to the Prior Art*

16 *Murcko*

17 01. Murcko is directed to a method and apparatus to facilitate
18 network transactions (Murcko 1:18-20).

19 02. Murcko describes a system that enables communication
20 between buyers and sellers (Murcko 4:5-7). A seller specifies the
21 item to be sold and searches for buyers (Murcko 4:8-14). The
22 seller then provides the item or a description of the item to the
23 buyer (Murcko 4:16-19). The system assigns a unique tracking ID
24 to the item and is sent to each buyer (Murcko 4:23-25). The buyer

1 then views the item sent and specifies payment amounts to the
2 seller or requests additional information (Murcko 4:25-29). After
3 the buyer submits payments to the system, the system sends the
4 payment to the seller (Murcko 4:29-31).

5 03. Buyers can also submit a Buyer Item Request form that allows
6 buyers to specify items they would like to buy, which sellers they
7 are interested in buying from, and other information (Murcko
8 27:20-31). Buyers can also specify or provide guidance about
9 what payment amount they will be willing to pay for the desired
10 item (Murcko 27:64-67). A buyer can further specify a cutoff
11 percentile for sellers providing items or specify a cutoff percentile
12 for each item requested (Murcko 28:1-6). A buyer would indicate
13 a cutoff percentile for sellers in order to specify which sellers will
14 accept the buyer paying an average payment of a certain amount
15 (Murcko 28:7-13). All payments will be assigned a payment date
16 and buyers will have to pay an additional fee for late payments
17 (Murcko 28:61-65).

18 *Benton*

19 04. Benton is directed to a unique electronic funds transfer system
20 incorporating facsimile machines both to transfer funds data
21 between buyers and sellers at a common point of sale or at remote
22 locations and to print transaction records including facsimile
23 signatures of the parties (Benton 1:13-19).

1 *O'Hagan*

2 05. O'Hagan is directed to a system for optically extracting indicia
3 from a coupon and employing the extracted indicia within the
4 network to facilitate customer shopping, manufacturer marketing,
5 and store efficiency (O'Hagan 1:14-19).

6 06. O'Hagan specifically describes a system that allows a customer
7 to scan coupons at home such that the customer maintains an
8 electronic list of coupons (O'Hagan 3:13-20). The customer
9 further can create a shopping list to compliment the coupon list
10 and go to the store at a time of convenience (O'Hagan 3:20-24).
11 At the store, the customer uses a shopping cart equipped with a
12 portable device to assist the customer to shop efficiently and to
13 scan items as the customer places the items into the shopping cart
14 (O'Hagan 3:25-42).

15 07. In order to add an item on to a shopping list, a user enters or
16 scans the barcode information (O'Hagan 20:60-62). The system
17 retrieves product data and returns a confirmation page that
18 includes product information such as product price, product
19 availability, coupons, discounts, terms on coupons/discounts, etc.
20 (O'Hagan 21:11-16). After the user selects whether to add the
21 item, the home terminal connects to a merchant's computer,
22 transmits new coupon list information, and updates the product
23 information on the confirmation page, including product price,
24 product availability, coupons, discounts, terms on
25 coupons/discounts etc. (O'Hagan 21:40-57). The customer

1 shopping list includes information as to how long the price quote
2 will remain in effect, the time of purchase of the product, and the
3 price paid by the customer (O'Hagan 23:41-57). The customer
4 pays the lower of the price of the product being offered at the store
5 or the price quoted previously using the system (O'Hagan 28:44-
6 50).

7 *Walker*

8 08. Walker is directed to a method and apparatus for providing
9 discounts (Walker 1:31-32).

10 ANALYSIS

11 *Claims 1, 4, 7, 10, and 13-42 rejected under 35 U.S.C. § 103(a) as being*
12 *unpatentable over Murcko and Benton*

13 The Appellant first contends that (1) Murcko, Benton, O'Hagan, and
14 Walker fails to describe "wherein said second electronic document
15 comprises a formula for calculating a payment price based on said order
16 issuer's payment date" as required by limitation [10] of claim 1 (App. Br.
17 16-19). The Appellant specifically argues that Murcko describes the buyer
18 provides the payment amount they might be willing to pay, rather than a
19 formula as claimed (App. Br. 17-18). We disagree with the Appellant.
20 First, we note that limitation [10] only requires that the formula is based on
21 the issuer's payment date. There are no other limitations required of the
22 formula. As such, limitation [10] only requires any adjustment to the
23 payment price that is based on the issuer's payment date.

1 Murcko describes a system that facilitates communication between
2 buyers and sellers, where a buyer can describe the item and the price the
3 buyer is willing to pay (FF 01-02). Murcko further describes that a buyer
4 can specify a cutoff percentile for each requested item (FF 03). A buyer can
5 also specify a cutoff percentile for sellers, where the cutoff condition is for
6 sellers that will accept an average payment amount (FF 03). Payment is also
7 required on a specific date and if payment is not timely received additional
8 fees are assessed (FF 03). That is, the amount due is adjusted based on a
9 formula to account for payments that are not received on the payment date
10 and the amount due is increased by the late fee amount.

11 The Appellant further argues that the late fee, as described by Murcko, is
12 merely a fee added to the set payment amount (Reply Br. 5). Although a late
13 fee is a fee added to the payment amount, the Appellant has failed to provide
14 any rationale that distinguishes how Murcko's description of a formulaic
15 adjustment of the payment amount based on the payment date is
16 distinguished from the claimed invention. As such, the Appellant's
17 argument is not found persuasive. Therefore, Murcko describes more than
18 just allowing a buyer to dictate how much they are willing to pay; Murcko
19 describes that payment options are provided such that the buyer can submit a
20 formula that cutoffs off potential sellers and further describes formula to
21 adjust the amount due if payment is not received by the payment date.

22 The Appellant also argues that Benton, O'Hagan and Walker fail to
23 describe limitation [10] of claim 1 (App Br. 19). However, the Examiner
24 has relied on Murcko to describe this feature. As such, the Appellant's
25 contention does not persuade us of error on the part of the Examiner because
26 the Appellant responds to the rejection by attacking the references

1 separately, even though the rejection is based on the combined teachings of
2 the references. Nonobviousness cannot be established by attacking the
3 references individually when the rejection is predicated upon a combination
4 of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097
5 (Fed. Cir. 1986).

6 The Examiner did not err in rejecting claims 1, 4, 7, 10, and 13-42 under
7 35 U.S.C. § 103(a) as unpatentable over Murcko and Benton.

8
9 *Claims 2-3, 5-6, 8-9, and 11-12 rejected under 35 U.S.C. § 103(a) as*
10 *being unpatentable over Murcko, Benton, and O'Hagan*

11 The Appellant contends that O'Hagan fails to describe "calculating a
12 reduced price corresponding to...said order issuer's payment date on said
13 order accepting device" as required by claims 2 and 5 (App. Br. 20). We
14 disagree with the Appellant. In rejecting claims 2 and 5, the Examiner relied
15 on O'Hagan to describe this feature (Ans. 7-8). O'Hagan describes an
16 electronic shipping system that allows a user to scan coupons at home, create
17 a shopping list, and shop at the store at the user's convenience (FF 06-07).
18 O'Hagan describes that when a user selects an item to be placed in the
19 shopping list, the system displays a confirmation that includes product
20 information (FF 07). The product information includes product price,
21 product availability, coupons, discounts, terms on coupons/discounts, etc.
22 (FF 07). Once a user selects a product to be added to the shopping list, the
23 user's terminal connects to a merchant's computer and updates the product
24 information (FF 07). That is, the user's shopping cart displays and
25 calculates discounted prices based on coupons and discounts. The system

1 further incorporates the terms and conditions of the coupons and discounts,
2 such as their time of expiration (FF 07). The Appellant agrees that O'Hagan
3 describes the confirmation page, but fails to set forth any rationale to
4 distinguish the claimed invention from O'Hagan. As such, we find that
5 O'Hagan describes this limitation of claims 2 and 5.

6 The Appellant further contends that Murcko and Benton fail to describe
7 this limitation. However, the Examiner relied on O'Hagan in the rejection
8 of these claims. As such, the Appellant's contention does not persuade us of
9 error on the part of the Examiner because the Appellant responds to the
10 rejection by attacking the references separately, even though the rejection is
11 based on the combined teachings of the references. Nonobviousness cannot
12 be established by attacking the references individually when the rejection is
13 predicated upon a combination of prior art disclosures. *Id.*

14 The Examiner did not err in rejecting claims 2-3, 5-6, 8-9, and 11-12
15 under 35 U.S.C. § 103(a) as unpatentable over Murcko, Benton, and
16 O'Hagan.

17 *Claims 43-47 rejected under 35 U.S.C. § 103(a) as being unpatentable*
18 *over Murcko, Benton, and Walker*

19 The Appellant contends that claims 43-47 depend from the independent
20 claims and are allowable for the same reasons provided in support of those
21 claims *supra* (App. Br. 20). We disagree with the Appellant. The
22 Appellant's arguments were not found persuasive *supra* and are not found
23 persuasive here for the same reasons. As such, the Examiner did not err in
24 rejecting claims 43-47 under 35 U.S.C. § 103(a) as unpatentable over
25 Murcko, Benton, and Walker.

1

2

CONCLUSIONS OF LAW

3 The Examiner did not err in rejecting claims 1, 4, 7, 10, and 13-42 under
4 35 U.S.C. § 103(a) as unpatentable over Murcko and Benton.

5 The Examiner did not err in rejecting claims 2-3, 5-6, 8-9, and 11-12
6 under 35 U.S.C. § 103(a) as unpatentable over Murcko, Benton, and
7 O'Hagan.

8 The Examiner did not err in rejecting claims 43-47 under 35 U.S.C.
9 § 103(a) as unpatentable over Murcko, Benton, and Walker.

10

11

DECISION

12 To summarize, our decision is as follows:

- 13 • The rejection of claims 1, 4, 7, 10, and 13-42 under 35 U.S.C.
14 § 103(a) as unpatentable over Murcko and Benton is sustained.
- 15 • The rejection of claims 2-3, 5-6, 8-9, and 11-12 under 35 U.S.C.
16 § 103(a) as unpatentable over Murcko, Benton, and O'Hagan is
17 sustained.
- 18 • The rejection of claims 43-47 under 35 U.S.C. § 103(a) as
19 unpatentable over Murcko, Benton, and Walker is sustained.

20

21 No time period for taking any subsequent action in connection with this
22 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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